INTRODUCTORY REMARKS

The Applicants first wish to thank Examiner Richter and Examiner George for the telephonic interview on Monday, May 19, 2008, and for Examiner George's telephone call to the undersigned on that date indicating the allowability of the application.

As Examiner George requested the Applicants to submit a response to the office action which would prompt the issuance the Notice of Allowance, the following remarks are provided.

REMARKS

The office action of February 28, 2008, finally rejected all of the claims, 3-5, 7-13, 21-24 and 26, under 35 U.S.C. §112, second paragraph, as being indefinite for the reason stated in the office action dated August 6, 2007. The rejection stated in the prior office action and repeated in the outstanding office action is as follows:

> Claims 3-5, 7-13, 21- 14 [sic] (Applicants assume that the Examiner intended claim 24 and not claim 14 as stated) and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants in the claims recite the phrase "derivatives". Webster's Dictionary defines a derivative as "a substance derived from, or of such composition and properties, that it may be considered as derived from, another substance by chemical change, esp. by the substitution of one or more elements or radicals". Based on this definition it is unclear what the derivative is.

In the Applicants' response to the office action of August 6, 2007, the following remarks were provided:

This rejection is respectfully traversed. "The purpose of the definiteness requirement is so that the public may determine the boundaries of the claimed invention." *United Carbon Co. v. Binney Co.*, 317 US 228 (1942). "The definiteness of the language employed must be analyzed-not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art." *In re Moore and Janoski*, 169 USPQ 236 (CCPA 1971). It first must be appreciated that the term

"derivative" does not stand alone. The terms employed in the present application actually are "cholesterol derivatives" and "oil-soluble cellulose derivatives".

The U.S. Patent and Trademark Office has issued numerous patents which use the term "cholesterol derivatives". As just a few examples, mention may be made of U.S. Patent No. 5,885,948 (see col. 10, line 16, and claims 4, 6); U.S. Patent No. 6,033,680 (see col. 6, lines 27, 28, col. 7, line 3, and claim 4); U.S. Patent No. 6,080,707 (see col. 12, line 5, 20, and claims 4 and 7).

In fact, the meaning of "cholesterol derivatives" must also be clear to the Examiner. In the office action of January 12, 2007, the Examiner rejected the claims as anticipated by Wivell et al. (US 5,599,549). The rejection stated in relevant part:

> Wivell et al. teaches a personal cleansing composition comprising an oil phase wherein the oil phase can comprise cholesterol, cholesterol derivatives... (col. 4, lines 48-56).

The patent, at col. 5, lines 27-30, defines cholesterol derivatives as follows: "Examples of cholesterol and cholesterol derivatives include cholesterol, and cholesterol esters and ethers (e.g. cholesterol stearte [*sic*], cholesterol isostearate [*sic*], cholesterol acetate and the like)."

Moreover, the present application provides an example of a preferred cholesterol derivative, "lanosterol" at page 3, lines 16, 17, in Example 1, and in claim 8.

It is the Applicants' position that those of ordinary skill in the art would be suitably guided by the disclosure in the present application in selecting appropriate derivatives of cholesterol so as to make and use the claimed invention.

Turning now to the term "oil soluble derivatives of cellulose", it is clear, for example, from a reading of U.S. Patent No. 5,891,450 (see cols. 1, 2) and U.S. Patent No. 4,536,405 (see cols. 1, 4, 5 and claim 5) that the term "cellulose derivatives" has been typically used in cosmetics. However, from U.S. Patent No. 4,536,405, it may also be appreciated that these cellulose derivatives have generally been water soluble rather than oil soluble (see col. 1, lines 25-47 and the references, in particular, to "organosoluble cellulose derivatives"). Nevertheless, the patent discloses that an oil soluble cellulose derivative, ethyl cellulose, had been known for use in lip rouge, and further describes additional cellulose derivatives which are both water and oil soluble (see cols. 4-6). Furthermore, the term "oil soluble derivatives of cellulose" is discussed in many other patents issued by the U.S. Patent and Trademark Office. As examples,

mention may be made of U.S. Patent No. 2,197,768 (see page 12, right hand column, lines 17, 18); U.S. Patent No. 4,740,571 (see col. 6, lines 15-18) and U.S. Patent No. 5,114,577 (see col. 6, lines 11-13).

Moreover, the present specification, at page 3, line 19 provides a preferred example of an oil soluble cellulose derivative, i.e. ethyl cellulose, for the claimed purposes. Clearly, the present application would provide sufficient guidance to those having ordinary skill in the art in selecting appropriate oil soluble cellulose derivatives for the successful operation of the present invention.

In light of the arguments presented above, the rejection under 35 U.S.C. §112, second paragraph, should be withdrawn, as it is unfounded. One of ordinary skill in the art, armed with the knowledge of the prior art, would find sufficient guidance in the present application to select appropriate cholesterol derivatives and oil soluble cellulose derivatives to make and use the claimed invention. It is believed that the claims are in condition for allowance, and a Notice of Allowance is respectfully solicited.

In the office action of February 28, 2008, the Examiner provided the following "Response to Arguments":

> Applicant's arguments filed October 8, 2007 have been fully considered but they are not persuasive.
> The examiner is withdrawing the rejection with respect to cholesterol derivatives, as the applicant has defined it in the claims as lanosterol. However, the rejection is being maintained with respect to oil-soluble derivatives. Applicant argues that in US patents 5,891,450 and 4,536,405 disclose examples of these derivatives. While examples may be disclosed in those patents, the claims of the instant invention are silent with respect to these derivatives. Furthermore, a derivative could encompass a salt, hydrate, ester, etc. Therefore, it is considered to the examiner as indefinite
> Claims 305, 7-13, 21-24 and 26 remain rejected.

The Applicants attempted to contact the Examiners to arrange a telephonic interview, and finally efiled an "Applicant Initiated Interview Request Form" on May 6, 2008, and followed up with a telephone call to Examiner George on May 12, 2008. Examiner George conferred with Examiner Richter and confirmed to the undersigned the date of May 19, 2008 at 1 pm for the telephonic interview.

Substance of the Interview

Examiners Richter and George were present with the undersigned for the telephonic interview of May 19, 2008. The undersigned requested clarification of the claim rejections for indefiniteness for use of the phrase "oil soluble cellulose derivatives" under 35 U.S.C. §112, second paragraph, particularly in view of the withdrawal of the claim rejections for use of the phrase "cholesterol derivatives". More specifically, Examiner George had withdrawn the latter rejection, since the present claims recite an example of a specific cholesterol derivative. The undersigned remarked that she was not aware of any rule which required a specific example to be recited in the claims, and that the claims must be read in light of the disclosure in the entire specification, which provided a specific example of an oil soluble derivative of cellulose, ethyl cellulose. Examiner George advised that the phrase "oil soluble derivatives of cellulose" could include a salt, hydrate, ester, etc.

The undersigned referred to the decision in *Halliburton Energy Services, Inc. v. M-I LLC*, 85 USPQ2d 1654 (CAFC 2008), which reviewed how the court had applied the definiteness requirement of 35 U.S.C. §112, paragraph 2, in numerous cases, the court concluding: "The common thread in all of these cases is that claims were held indefinite only where a person of ordinary skill in the art could not determine the bounds of the claims, i.e., the claims were insolubly ambiguous." The undersigned remarked that, in the present case, it was not the case that the claims are insolubly ambiguous. (Examiner Richter volunteered that his reading of the case was that the court needed to be more stringent.) The undersigned again referred the Examiners to the fact that an example of a preferred oil soluble cellulose derivative, ethyl cellulose, is provided in the description in the present specification. Examiner Richter then requested that the Applicants needed to provide references which indicated that those skilled in the art would recognize and understand the meaning of "oil soluble cellulose derivatives".

The undersigned reminded the Examiners that such patents had been identified in the Applicants' response to the previous office action. The patents included U.S. 2,197,768; 4,470,571; 5,114,577; and, in particular, U.S. Patent

4,536,405, which is specifically directed to derivatives of cellulose and their use in cosmetics. The undersigned indicated that, in column 1, lines 13-18 and 42-47, of the patent, a number of oil soluble derivatives of cellulose were identified, including the Applicants' preferred example, ethyl cellulose. The patent further disclosed additional oil soluble derivatives of cellulose which may be used in cosmetic compositions, and for the same purpose as that of the Applicants (i.e., thickening, as disclosed at column 6, in lines 26-28).

Examiner Richter then advised the undersigned that Examiner George would review U.S. patent 4,536,405, and that before the end of the day, the undersigned should be advised that the application would be allowed.

CONCLUSION

Later the same day, May 19, 2008, Examiner George telephoned the undersigned to advise her that he and Examiner Richter were convinced of the patentability of the invention and that Examiner George would forward to Examiner Richter his recommendations to issue a Notice of Allowance. Examiner George and the undersigned discussed preparing a Substance of the Interview and Examiner George advised the undersigned that he would do so. Examiner George telephoned the undersigned again on May 20, 2008, to advise her that she would need to submit a response to the final rejection which would prompt the issuance of the Notice of Allowance. This paper is being submitted in response to that requirement. The prompt issuance of the Notice of Allowance is respectfully requested.

Respectfully submitted,

Date: May 21, 2008

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